

BEST AVAILABLE COPY

Application No.: 10/753,072

Docket No.: 200315243-1 US (1509-479)

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 2-16, 18-21, 23-38 and 40-45 are pending in the application. Claims 1, 17, 22 and 39 have been cancelled without prejudice or disclaimer. Claims 2 and 20 have been rewritten in independent form including all limitations of base claims 1 and 17, respectively. Claims 23-25 have been amended to better define the claimed invention. The other original dependent claims have been amended to reflect the amended language of their respective independent claims. New claims 44-45 have been added to provide Applicants with the scope of protection to which they are believed entitled. The amended/added claims find solid support in the original specification, e.g., at page 7, line 23, and the original drawings. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 101 rejection of claim 22 is moot as claim 22 has been cancelled.

The 35 U.S.C. 101 rejection of claims 17-21 and 25 is traversed, because the rejected claims, contrary to the Examiner's allegation, are directed to statutory subject matter under 35 U.S.C. 101.

The statute states, in relevant part, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor . . ." See 35 U.S.C. 101 (emphasis added). A "process" is defined to encompass "[a] process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." See 35 U.S.C. 100(b) (emphasis added).

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Claims 17-21 and 25 of the present application are directed to "[a] method of converting an implementation module" as recited in independent claims 17 (now amended claim 20) and 25. Applicants respectfully submit that each of claims 17-21 and 25 is directed to a method, which is included in the statutory definition of a "process," and is therefore expressly included in one of the categories of statutory subject matter provided in 35 U.S.C. 101.

Furthermore, Applicants submit that the subject matter claimed in claims 17-21 and 25 does not fall within the judicially defined exceptions to patentable subject matter, i.e., laws of nature, natural phenomena, or abstract ideas. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

With respect to the Examiner's indication that claims 17-21 and 25 are "not tied to a technological art,..." Applicants respectfully submit that this rationale for claim rejections under 35 U.S.C. 101 has been obviated by a recent precedential decision of the Board of Patent Appeals and Interferences ("BPAI"). In *Ex parte Lundgren*, the BPAI expressly rejected the "technological arts" test, holding that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." See 2004 WL 3561262 (Bd.Pat.App & Interf. April 20, 2004), at *5.

With respect to the Examiner's indication that the claims are rejected because none of the claims required the use of hardware for accomplishing the recited steps, the Examiner is kindly asked to cite legal authority for the requirement that claims directed to a process or method necessarily include citation to hardware.

For at least the above advanced reasons, the Applicants respectfully submit that claims 17-21 and 25 are directed to statutory subject matter as defined by 35 U.S.C. 101, and request withdrawal of the rejection.

The 35 U.S.C. 103(a) rejections of all original claims as being obvious over the primary reference of *Saboff* (U.S. Patent No. 6,154,878) in view of other teaching references are noted.

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implementation library. In fact, *Saboff*, as discussed in the specification of the instant application at page 2, line 3, permits the state information to be kept in the implementation library, and therefore appears to teach away from the claimed requirements that no state information of the implementation module be stored within the implementation module (claim 2) and that no global variables which hold state information of the implementation module be left within the implementation module (claim 20).

Accordingly, Applicants respectfully submit that even if the references were properly combinable in the manner the Examiner proposes, the combined method/system would still fail to teach or disclose the limitations of claims 2 and 20. Claims 2 and 20 are clearly patentable over the art as applied by the Examiner. Claims 3-16, 18-19, 21 and new claims 44-45 depend from claim 2 or 22, and are considered patentable at least for the reasons advanced above with respect to claims 2 and 22.

The remaining claims, especially independent claims 23-25, have been amended to include limitations similar to those of claims 2 and 20, and are therefore believed patentable for the same reasons advanced with respect to claims 2 and 20.

Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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Applicants respectfully traverse, at least, the rejections of claims 2 and 20, because a prima facie case of obviousness has not been properly established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *MPEP*, section 2143.

Applicants respectfully submit that the Examiner's obviousness rejection has failed to meet at least the third criterion. In particular, the Examiner alleges that the proposed combination would include the limitation of claims 2 and 20 which are taught by *Saboff* at column 6, lines 38-45. Applicants respectfully disagree.

The cited passage is reproduced below from the Examiner's convenience of review.

The interface library, in addition to containing the proxy interfaces, contains global data associated with the implementation library. Making the global data in the interface library available to the application allows for direct access to the data by the application. This obviates the need for the application to relocate the data after an update of the implementation library. (We use "update" to include modification and replacement of an entire library.) The interface library can be created manually or could also be generated automatically from the implementation library.

A person of ordinary skill in the art would recognize that the teaching of the cited passage is that: the interface library contains global data of the implementation library. The cited passage does not supply any disclosure or suggestion of the feature of claim 2 that "no state information of the implementation module is stored within the implementation module" and the feature of claim 20 that "no global variables which hold state information of the implementation module are left within the implementation module." The fact that the *Saboff* global data/variables are contained in the interface library does not necessarily mean that such global data/variables are not stored within the

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-8025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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